

## REMARKS

In accordance with the foregoing claim 8 has been amended. Claims 2-5 and 7 remain cancelled and claims 9-11 are newly cancelled. Claims 1, 6, and 8 are pending and under consideration.

## ALLOWABLE SUBJECT MATTER

Applicant acknowledges with appreciation that claims 1 and 6 are allowed.

## CLAIM REJECTIONS UNDER 35 U.S.C. §103

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Prior Art Figures 1 and 2 in view of U.S. Patent No. 7, 061,657 to Fishman et al (hereinafter "Fishman"). Claim 8 is also rejected under 35 U.S.C. 103(a) as being unpatentable over Prior Art Figures 1 and 2 in view of U.S. Patent No. 6,271,948 to Toyohara (Toyohara).

Claim 8 is amended herewith. The claim 8 amendments are supported by the originally filed specification and claims, for example, see FIGS. 3 and 4 (elements 40 and 42), and in the specification page 5, line 13 through page 8 line 36. Applicant believes that amended claim 8 patentably distinguishes over the cited prior art as argued below.

Figure 1 of Fishman illustrates a plurality of WDM transmitters  $Tx_1$ - $Tx_n$  and one CDM transmission unit whose signals are input to a WDM multiplexer 11. The WDM multiplexer 11 outputs an optical signal to the optical link 12 which then transmits the signal to a demultiplexer 16. The demultiplexer 16 demultiplexes the output of the optical link 12 and supplies the demultiplexed signals to a plurality of WDM receivers  $Rx_1$ - $Rx_n$  and one CDM receiving unit Rx. According to Fishman, two multiplexing methods are applied successively, first the CDM and then the WDM. However, Fishman does not teach or suggest wavelength division multiplexing of a WDM signal received after dispersion compensation and level adjustment, and "at least one other optical signal provided to the multiplexing unit through at least one transponder" as recited in amended claim 8. Fishman merely discloses the WDM multiplexer and the CDM transmitter combination at the input of the optical link, and, respectively, the WDM demultiplexer and the CDM receiver combination at the output of the optical link. Fishman does not teach or suggest the dispersion compensator and the amplifier as recited in claim 8.

Toyohara discloses a WDM system in which plural light sources of different wavelengths generate plural optical signals classified into several groups. Optical signals of a group are multiplexed by a coupler and the multiplexed signal is amplified before being multiplexed with

other amplified signals of other group signals and input to the optical transmission line. However, Toyohara does not teach or suggest the wavelength division multiplexing of a WDM signal received after dispersion compensation and level adjustment, and "at least one other optical signal provided to the multiplexing unit through at least one transponder" as recited in amended claim 8. Toyohara does not teach or suggest the dispersion compensator and the amplifier as recited in claim 8.

Moreover, Toyohara does not teach or suggest the separating unit splitting the output of the transmission line into "a second plurality of optical client signals and a third plurality of optical client signals, separates the second plurality of optical client signals from the third plurality of optical client signals, while keeping wavelengths of the second plurality of optical client signals multiplexed together" and "[transmitting] the separated second plurality of optical client signals to a place which is different from where the third plurality of optical client signals is transmitted, while keeping the wavelengths of the second plurality of optical client signals multiplexed."

Applicant respectfully submit that claim 8 is patentable because neither Toyohara nor Fishman in combination with the prior art, teaches or suggests all the features of amended claim 8.

Additionally, the outstanding Office Action asserts that the proposed combinations of the prior art described in the specification and Fishman or Toyohara would have been obvious **"since allowing to provide an optical communication system with high speed and high capacity."**<sup>1</sup> However neither Fishman nor Toyohara provides the motivation to perform the proposed combination. In other words, the Office Action performs an impermissible hindsight reconstruction of the claimed invention by improperly picking and choosing features from different references, and then asserts indiscriminately as motivation the synergetic result obtained by the claimed invention. While the required evidence of motivation to combine need not come from the applied references themselves, the evidence must come from *somewhere* within the record.<sup>2</sup> In this case, the record fails to support the proposed combinations.

Claims 9-11 are also rejected under 35 U.S.C. 103(a). Claims 9-11 are cancelled herewith.

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<sup>1</sup> See outstanding Office Action at page 4, lines 3-5, and at page 8, lines 9-11.

<sup>2</sup> *In re Lee*, 277 F.3d 1338, 1343-4, 61 USPQ2d 1430 (Fed. Cir. 2002) ("The factual inquiry whether to combine references ... must be based on objective evidence of record. ... [The] factual question of motivation ... cannot be resolved on subjective belief and unknown authority. ... Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion").

**CONCLUSION**


There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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